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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/007,360	10/29/2001	Peter M. Bonutti	BON-4250-1	3765
33771	7590	07/09/2004	EXAMINER	
PAUL D. BIANCO: FLEIT, KAIN, GIBBONS, GUTMAN, BONGINI, & BIANCO P.L. 601 BRICKELL KEY DRIVE, SUITE 404 MIAMI, FL 33131			ROBERT, EDUARDO C	
			ART UNIT	PAPER NUMBER
			3732	

DATE MAILED: 07/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/007,360

Applicant(s)

BONUTTI, PETER M.

Examiner

Eduardo C. Robert

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 5-7, 16, 22, 28, 29, 46-51, 64, 65, 69, 74-84, 86, 87, 101-108, 116, 117, 119-135, and 138 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1, 5-7, 16, 46-51, 64, 65, 129-135 and 138 is/are allowed.
- 6) ☒ Claim(s) 74, 75, 78 and 120-124 is/are rejected.
- 7) ☒ Claim(s) 75 and 76 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Continuation of Disposition of Claims: Claims withdrawn from consideration are 22, 28, 29, 69, 79-84, 86, 87, 101-108, 116, 117, 119, 125, 127, and 128 .

DETAILED ACTION

Election/Restrictions

The claims status is the following:

Claims 1, 5-7, 16, 22, 28, 29, 46-51, 64, 65, 69, 74-84, 86, 87, 101-108, 116, 117, 119-135, and 138 are pending in this application.

Currently, there is no generic claims (see reasons set forth in the action mailed on January 21, 2004).

Claims 22, 28, 29, 69, 79-84, 86, 87, 101-108, 116, 117, 119, 125, 127, and 128 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. The election has been treated as an election **without traverse** (see reasons set forth in the action mailed on January 21, 2004).

In response to applicant's argument that claim 125 was inadvertently omitted from the list of claims that read on the elected species, but it should be included since it reads on the species, it is noted that applicant election was without traverse and applicant clearly stated that claim 125 was not readable on the elected species and even now it does not appear to read on the elected species. Claim 125 appears to be directed to a permutation of the elected species, which may be considered as another species. With regard to applicant's argument that claim 125 was listed with the pending claims list, it is noted that all claims that are withdrawn are "pending" until they are cancel. Thus, claim 125 was pending and it is still pending, however, it has been withdrawn from further consideration. With regard to claims 126 and 128, these claims were not

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examined because they were depended from a withdrawn claim, These claims were mistakenly included into the readable claims because of the numerous of claims presented and now properly indicated as withdrawn.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 74, 75, 78, and 120-124 are rejected under 35 U.S.C. 103(a) as being unpatentable over Galluzzo (U.S. Patent 4,869,242) in view of Reed (U.S. Patent 5,868,749).

Galluzzo discloses a retainer member 10, i.e. pin, and method wherein the retainer member 10 is made from any biocompatible material (see col. 1, line 60) and the method includes the steps of moving the retainer member through a portion of a first bone and into a second bone, wherein the first and second bone are hold against movement relative to each other with the retainer member. The first and second bones are different bones in the patient's body (see Figures 4 and 5). The retainer member 10 is driven into the bones by a force applied against an trailing end of the retainer member, thus forming an opening. The retainer member is inserted a predetermined distance. Galluzzo discloses the claimed invention except for the retainer member being made from bone. Reed teach to construct retainer members such as screws, pins, etc. from bone in order to reduce the potential of trauma and/or possible irritation and sterile abscess (see col. 1, line 44, through col. 2, line 11). It would have been obvious to one skill in the

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art at the time the invention was made to practice the method of Galluzzo with retainer members made from bone in view of Reed, in order to reduce potential trauma and/or irritation and sterile abscess to the treated site. Furthermore, it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Allowable Subject Matter

Claims 1, 5-7, 16, 46-51, 64, 65, 129-135, and 138 are allowed.

Claims 75 and 76 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 for art cited of interest.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

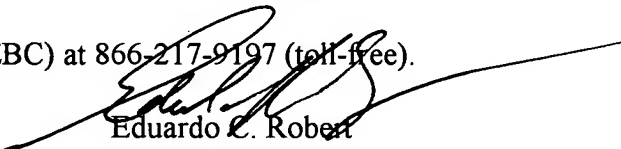
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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eduardo C. Robert whose telephone number is 703-305-7333. The examiner can normally be reached on Monday-Friday, 9:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin P. Shaver can be reached on 703-308-2582. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Eduardo C. Robert
Primary Examiner
Art Unit 3732

E.C.R.